

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Marvin L. Boerboom

Serial No.: 10/804,589

Filed: March 19, 2004

For: PLANTS AND SEEDS OF CORN
VARIETY I900420

Group Art Unit: 1638

Examiner: Fox, D.

Atty. Dkt. No.: DEKA:327US

CERTIFICATE OF ELECTRONIC SUBMISSION

Date of Submission: December 11, 2006

RESPONSE TO 37 C.F.R. §1.105 REQUEST

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This paper is submitted in response to the 37 C.F.R. §1.105 Request dated August 9, 2006 for which the deadline to respond is December 11, 2006 in view of the enclosed petition for extension of time and fees. No additional fees are believed due in connection with this paper. However, should any such fees become due, consider this paragraph a request and authorization to withdraw the appropriate fee under 37 C.F.R. §§ 1.16 to 1.21 from *Fulbright & Jaworski, L.L.P.* Account No. 50-1212/DEKA:327US.

REMARKS

Applicants provide the following information and remarks responsive to the requests made in paragraph 3 of the 37 C.F.R. §1.105 Communication as known and readily obtained by Applicants pursuant to this section:

(i) The original parents from which corn variety I900420 was developed are designated 01DHD16 and 87DIA4. Variety 87DIA4 also has the designations HC50, HXN2, PS10504 and SGI902. 01DHD16 also has the designations HCL237 and SGI812. 01DHD16 and 87DIA4 are believed to have been on sale or in public use as of the filing date and thus “publicly available” as that term is used in the Request. Applicants understand this term to refer to whether the parent plants had been on sale or in public use as of the priority date of the current application. Clarification is respectfully requested if this interpretation is not what was intended.

(ii) Corn variety I900420 was developed as follows:

Winter 1995-1996	The inbred line 01DHD16 (a proprietary Monsanto inbred) was crossed to the inbred line 87DIA4 (a proprietary Monsanto inbred) in the Kihei Hawaii winter nursery rows E10 (01DHD16) x E83 (87DIA4) by hand carrying pollen from E10 to E83.
Summer 1996	The S0 seed was grown and self-pollinated in nursery range/row 215-67 in Olivia Minnesota.
Summer 1997	The S1 seed was grown in the Olivia summer nursery and self-pollinated in nursery rows 15-1 to 15-34. 106 ears were selected.
Summer 1998	S2 ears were grown ear-to-row and self-pollinated in Olivia Minnesota. 3 ears were selected in nursery range/row 115-48.
Summer 1999	S3 ears were grown ear-to-row and self-pollinated in nursery row 104-74 at Olivia Minnesota. 3 ears were selected.
Winter 99-2000	S4 ears were grown ear-to-row and self-pollinated in Mexico winter nursery rows 91SS 7067-7072. Row 7067

was selected and advanced 10 ears and designated Corn Variety **I900420**.

(iii) As indicated above, lines 01DHD16 and 87DIA4 had been “publicly available” as of the filing date. For example, 01DHD16 is protected by Patent No. 6,096,952 issued August 1, 2002. 87DIA4 is protected by Patent No. 5,936,145 issued August 10, 1999 and by PVP Certificate No. 9800303, issued May 2, 2002. The extent of disclosure of progeny of 01DHD16 and 87DIA4 is provided under item (iv).

(iv) At or before the time of filing of the instant application there are believed to have been 27 other corn line produced using said method and said parental corn lines as follows:

17DUD2	01DHD16/87DIA4
17DUD3	01DHD16/87DIA4
17DUD4	01DHD16/87DIA4
64DUD1	01DHD16/87DIA4
64DUD10	01DHD16/87DIA4
64DUD4	01DHD16/87DIA4
64DUD4B	01DHD16/87DIA4
83DUD1	01DHD16/87DIA4
83DUD11	87DIA4*2/01DHD16
83DUD12	87DIA4*2/01DHD16
83DUD2	01DHD16/87DIA4
83DUD3	01DHD16/87DIA4
83DUD6	87DIA4*3/01DHD16

87DUD2	87DIA4*2/01DHD16
87DUD3	87DIA4*2/01DHD16
87DUD4	87DIA4*2/01DHD16
87DUD6	01DHD16/87DIA4
89DUD3	01DHD16/87DIA4
91DUD16	01DHD16/87DIA4
91DUD17	01DHD16/87DIA4
91DUD22	87DIA4*2/01DHD16
91DUD27	01DHD16/87DIA4
91DUD3	01DHD16/87DIA4
91DUD4	01DHD16/87DIA4
91DUD6	01DHD16/87DIA4
91DZD1	01DHD16/87DIA4
91DZD2	01DHD16/87DIA4

At the time of filing of the instant application, none of corn lines above are believed to have been publicly available or on sale except 89DUD3 and 91DUD4.

CONCLUSION

This is submitted to be a complete response to the referenced Communication. In conclusion, Applicant submits that the present case is in condition for allowance and such favorable action is respectfully requested.

The Examiner is invited to contact the undersigned at (512) 536-3085 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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